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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,398	01/02/2002	K. Ranji Vaidyanathan	003248.00041	8382
22908	7590	08/12/2005	EXAMINER	
<b>BANNER &amp; WITCOFF, LTD.</b> TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606				BARRETT, THOMAS C
		ART UNIT		PAPER NUMBER
		3738		

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No. 10/038,398	Applicant(s) VAIDYANATHAN ET AL.
	Examiner Thomas C. Barrett	Art Unit 3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 13 May 2005.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1,2,4-13 and 15-28 is/are pending in the application.

4a) Of the above claim(s) 9,10 and 16-24 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4-8,11-13,15 and 25-28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</p>	<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>
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**DETAILED ACTION**

**REQUEST FOR CONTINUED EXAMINATION**

The request filed on May 13, 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/038,398 is acceptable and a RCE has been established. An action on the RCE follows.

***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 4-13, and 15-28 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 recites the limitation, "a ceramic composition selected from the group consisting of polylactic acid, polyglycolic acid, polylactic acid-polyglycolic acid copolymer, polycaprolactone, and combinations thereof..." However none of these are ceramic compositions. It is unclear what is actually being claimed; a polymer-ceramic composition, the polymer of a polymer-ceramic composition or just a polymer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walish et al. (Symposium Y) in view of DeBruijn et al. (6,228,117 B1). Walish et al. discloses a biocompatible osteoinductive implant comprising a porous composition that provides load-bearing support for bone, further comprising a polymer-ceramic composition, that degrades at a different rate then the first composition, however Walish et al. fails to disclose the polymer comprising polybutyleneterephthalate or polyethyletherketone. DeBruijn et al. teaches an engineered bone comprising polybutyleneterephthalate (PBT), which can also include growth factors. It would have been obvious to one of ordinary skill in the art to combine the teaching of a bone implant comprising PBT, as taught by DeBruijn et al., to a biocompatible osteoinductive implant as per Walish et al., the motivation to combine being a bioactive, PBT can be used to make an osteoconductive copolymer, as found in DeBruijn et al. (col. 4, lines 41-54).

Please note that the priority date of the present invention is January 2, 2002. The provisional applications cited fail to disclose polyethyletherketone, or its combination with PBT. In addition, it is requested that the Applicant supply copies of any handouts or other pertinent information in relation to "Symposium Y" if available.

Claims 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walish et al. (Symposium Y) in view of DeBruijn et al. (6,228,117 B1) as above in further view of Vyakarnam et al. (6,534,084). Walish et al. discloses a biocompatible osteoinductive implant comprising a porous composition however Walish et al. fails to disclose a specific porosity and pore size. Vyakarnam et al. teaches an implant having a porosity of 50-60% and pores sized between about 150 to about 400 microns, which would be similar to the naturally occurring structure (col. 5, line 66- col. 6, line 41). It would have been obvious to one of ordinary skill in the art to combine the teaching of an implant having a porosity of 50-60% and pores sized between about 150 to about 400 microns, as taught by Vyakarnam et al., to a biocompatible osteoinductive implant as per Walish et al., in order to better approximate the naturally occurring structure.

Claims 6, 8 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walish et al. (Symposium Y) in view of DeBruijn et al. (6,228,117 B1) as above in further view of Kumar (2002/0127391 A1). Walish et al. discloses a biocompatible osteoinductive implant comprising a porous composition however Walish et al. fails to disclose the polymer-ceramic composition comprising polylactic acid. Kumar teaches an implant having a coating comprising a ceramic-polylactic acid composition (0024). It would have been obvious to one of ordinary skill in the art to combine the teaching of an implant having a coating comprising a ceramic-polylactic acid composition, as taught by Kumar, to a biocompatible osteoinductive implant as per Walish et al., for resorption after implantation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Barrett  
Examiner  
Art Unit: 3738